

REMARKS/AGRUMENTS

Reconsideration of this application is respectfully requested. No new matter has been added.
The claims are patentable over the cited art of record.

Claims 23, 2, 3, 8, 24-31, 34-36, and 39 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Grossman et al. (US patent no. 5,907,321) in view of Picco et al. (US patent no. 6,029,045), and Kitsukawa et al. (US patent no. 6,282,713).

Claims 5, 32, and 33 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Grossman et al. (US patent no. 5,907,321) in view of Picco et al. (US patent no. 6,029,045), Kitsukawa et al. (US patent no. 6,282,713), and Nathan et al. (US patent no. 6,182,126).

Claim 7 stands rejected under 35 USC 103(a) as allegedly being unpatentable over Grossman et al. (US patent no. 5,907,321) in further view of Picco et al. (US patent no. 6,029,045), Kitsukawa et al. (US patent no. 6,282,713), and Tsuria (US 5,786,845).

I. The 35 U.S.C. 103 rejection of claims 23, 2, 3, 8, 24-31, 34-36, and 39 is erroneous

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 23

The Examiner combined the teachings of Grossman et al. (US patent no. 5,907,321), Picco et al. (US patent no. 6,029,045), and Kitsukawa et al. (US patent no. 6,282,713) to reject claims 23, 2, 3, 8, 24-31, 34-36, and 39.

Grossman is concerned with displaying advertising information in response to the determination of a channel change (Grossman 2: 37-40). Picco is concerned with permitting a broadcaster to deliver geographically localized content (e.g., commercials targeted for a particular area of the country) over a national transmission medium, such as a satellite (Picco 2: 49-55). Kitsukawa is directed to on-demand electronic advertising, where the viewer is alerted when advertising information is available for an item displayed in a scene of the television program broadcast (Kitsukawa Abstract).

Neither Grossman, Picco, or Kitsukawa discloses an operation of “periodically downloading from a server selected data sets according to user profile information, the selected data sets representing information elements for display to a user during switching events”, as required by claim 23.

The Office Action admits that Grossman does not specifically disclose selected data sets according to user profile information, periodically downloading from a server selected datasets, and an interactive transaction system (Detailed Action, p. 4.). Although Picco discloses a plurality of content profiles that match some predetermined criteria (Picco 8: 10-15), and downloading private data to each set-top box by a trickle, i.e. background, download technique, a nightly download technique or a dual receiver technique (Picco 9:1-3), the downloaded private data is not “for display to a user during switching events”, as required by claim 23. In contrast, the local content in Picco is inserted into the programming data stream (Picco 6: 20-23, 38-40), as opposed to “during switching events” of claim 23. Furthermore, there is no suggestion or motivation to combine Picco with Grossman because the local content in Picco is inserted into the programming data stream (i.e., while a user is viewing a selected channel) (Picco 6: 20-23, 38-40), as opposed to situation described by Grossman where the visual image is displayed when a user *changes* the channels, during a delay between the displays of sequentially displayed channels (Grossman 3: 41-55).

Even if such teachings were combined, there is no reasonable expectation of success, because in Picco the local content is inserted into the programming data stream only when the local content space is identified within the compressed digital data stream (Picco 6: 20-23, 38-40), and thus displaying of local content in Picco is dependent on the availability of the local content space within the compressed digital data stream. Therefore, a combination of Grossman

and Picco would not yield the operation of “periodically downloading from a server selected data sets according to user profile information, the selected data sets representing information elements for display to a user during switching events”, as required by claim 23.

Neither Grossman nor Picco discloses an operation of “discontinuing the display of the first one of the information elements and displaying the data stream information from the server when it becomes available for such display, unless the user has initiated *an interactive transaction session with a remote host* by selecting an interactive element associated with the first one of the information elements in which case displaying the data stream information from the server is delayed until termination of the interactive transaction session or expiration of a predetermined period of inactivity by the user”, as required by claim 23.

Kitsukawa et al. (US 6,282,713) is cited for teaching an interactive transaction system. Kitsukawa discloses on-screen advertisements, which are superimposed over a television broadcast, and which include interactive elements, selectable to initiate an interactive session (Kitsukawa et al. Abstract). Kitsukawa also discloses providing coupon information for items used in scenes of television programs and commercials (Kitsukawa et al. 10:43-50). However, it is questionable whether one of ordinary skill in the art would have realized that such use of information elements with interactive elements could have been adapted for use in the system taught by Grossman. For example, Grossman is concerned with the display of information during times other than when a television picture is being displayed, i.e., during the delay period between the displays of sequentially displayed channels (Grossman et al. 3: 46-55). Kitsukawa, on the other hand, is concerned with displaying information superimposed on a television picture (Kitsukawa et al. 10:43-50).

Furthermore, there is no indication in Grossman that the information displayed when the user changes channels is in any way dependent on or related to the content of the television picture. Kitsukawa, on the other hand, is concerned with displaying information directly related to the content of the television picture, i.e., providing coupon information for products and services used in the scenes of television programs (Kitsukawa et al. 10:43-50). Thus, one of ordinary skill in the art would not have been motivated to make the combination suggested by the examiner because the references themselves do not suggest such a combination and the problems being addressed therein are not at all similar. For these reasons, the combination of Grossman and Kitsukawa references does not yield “a method, comprising periodically downloading from a

server selected data sets according to user profile information, the selected data sets representing information elements for display to a user during switching events, displaying a first one of the information elements in response to initiation of a first switching event, and discontinuing the display of the first one of the information elements and displaying the data stream information from the server when it becomes available for such display, unless the user has initiated an interactive transaction session with a remote host by selecting an interactive element associated with the first one of the information elements in which case displaying the data stream information from the server is delayed until termination of the interactive transaction session or expiration of a predetermined period of inactivity by the user” as required by claim 23.

Thus, claim 23 is patentable over the references cited in the Office Action, whether considered separately or in combination with one another.

Claims 2, 3, 5, 7, 8, and 24-30 are allowable for at least the reason of being dependent on claim 23.

Claim 31

Neither Grossman, Picco, or Kitsukawa discloses “a set top box configured to periodically download from the server selected data sets according to user profile information, the selected data sets being included within the data stream and representing information elements for display to a user during switching events” as required by claim 31. Thus, claim 31 is allowable for at least the reasons articulated with respect to claim 23.

Claims 32-39 are allowable for at least the reason of being dependent on claim 31.

II. The 35 U.S.C. 103 rejection of claims 5, 32, and 33 is erroneous

1. Claims 5, 32, and 33 are allowable for at least the reason of being dependent on allowable independent claims.

2. Although Nathan is cited for teaching the storing of one data set in a buffer and another data set in a memory, wherein the data set in the buffer is replaced by the one in memory after the first data set in the buffer is transmitted for display, the applicants submit that a combination of Nathan and Grossman does not satisfy the Graham factual inquiry (MPEP 2141), as there is no

suggestion or motivation to combine the references (see also MPEP 2143.01). Specifically, Nathan disclosure relates to home digital audiovisual information recording and reproduction apparatus (Nathan 1:29-30), which allows the user to select and purchase a musical piece (Nathan: 12: 8-19). Grossman, on the other hand, is concerned with displaying advertising information in response to the determination of a channel change (Grossman 2: 37-40). Thus, one of ordinary skill in the art would not have been motivated to make the combination suggested by the examiner because the references themselves do not suggest such a combination and the problems being addressed therein are distinct.

III. The 35 U.S.C. 103 rejection of claim 7 is erroneous

1. Claim 7 is allowable for at least the reason of being dependent on allowable independent claim 23.
2. The Office Action submits that in order to obviate claim 7, it is necessary to combine Grossman, Picco, Kitsukawa, and Tsuria. However, there is no suggestion or motivation to combine these references for at least the reasons articulated with respect to the combination of Picco and Grossman, and with respect to the combination of Grossman with Kitsukawa, as the references themselves do not suggest such a combination and the problems being addressed therein are distinct.

IV. Conclusion

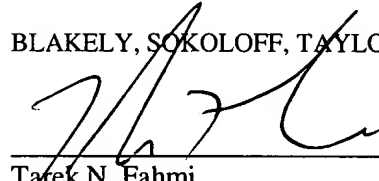
For at least the foregoing reasons, the claims are patentable over the references cited in the Office Action.

If there are any additional fees due in connection with this communication, please charge our deposit account no. 02-2666.

Respectfully submitted,

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